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EXAMINER

GUBIOTTI, MATTHEW P

ART UNIT PAPER NUMBER

2124

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,703

Applicant(s)

MISRA ET AL.

Examiner

Matthew Gubiotti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10, 13-21, 23-27, 29-36, 45-57, 59-61, 63-65, 68, 69 and 71-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10, 13-21, 23-27, 29, 45-57, 59-61, 63-65, 68, 69 and 71-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 30-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-6, 10, 13-21, 23-27, 29-36, 45-57, 59-61, 63-65, 68, 69 and 71-78 are pending in this application.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, 10, 13-21, 23-27, 29, 45-57, 59-61, 63-65, 68, 69 and 71-78, drawn to distribution of software, classified in class 717, subclass 177.

II. Claims 30-36, drawn to the encryption and decryption of values exchanged between computer systems, classified in class 308, subclass 278.

3. During a telephone conversation with Allan Sponseller, representative of Applicant (Reg. No. 38,318) on June 13th, 2003 a provisional election with traverse was made to prosecute the invention of a method and system for the licensing of software, claims 1-6, 10, 13-21, 23-27, 29, 45-57, 59-61, 63-65, 68, 69 and 71-78 (Group I, above). Affirmation of this election must be made by applicant in replying to this Office action. Claims 30-36 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 10, 13-21, 23-27, 29, 45-57, 59-61, 63-65, 68, 69 and 71-78 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of Misra et al. (U.S. Patent No.

6,189,146) (hereafter Misra). Although the conflicting claims are not identical, they are not patentably distinct from each other because the distinction is claimed subject matter are obvious in view of the disclosed prior art. For example:

Regarding Claim 1 in the instant application, the claim language merely omits elements present in Claim 1 of the Misra patent. At the time of the invention, it would have been

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obvious to one of ordinary skill in the art to omit certain elements of the patented claim in to expedite the functionality of the claimed method and system.

Regarding Claim 13 in the instant application, the claim language effectively restates the functionality of the method disclosed in Claims 1 and 2 of the Misra patent, relying on a terminology distinction between a "digital signature" encrypted for a "individual client" (as claimed in Misra) and a "digital certificate" distributed to "individual clients".

Regarding Claim 15 in the instant application the claim language merely combines claim elements present in Claim 6 of the Misra patent with the digital signature limitation present in Claim 1 of the Misra patent. At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the elements of the patented claim in order to further ensure the secure transfer of software licenses over a network.

Regarding Claim 21 in the instant application, the claim language merely omits elements present in Claim 6 of the Misra patent. At the time of the invention, it would have been obvious to one of ordinary skill in the art to omit certain elements of the patented claim in to expedite the functionality of the claimed method and system.

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Regarding Claim 69 in the instant application, the claim language merely omits elements present in Claim 20 of the Misra patent. At the time of the invention, it would have been obvious to one of ordinary skill in the art to omit certain elements of the patented claim in to expedite the functionality of the claimed method and system.

Additionally, the distinct limitations of the current application (See e.g. Claim 2: "creating a license pack containing a predefined number of software licenses") are obvious in view of the previously issue patent in view of Christiano (U.S. Pat. No. 5,671,412) discussed below.

Claim Rejections - 35 USC § 112

5. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites the limitation "issuing...digital certificates that *can be distributed...*" (emphasis added). The use of the term "can be" renders the details of the limitation that follow the term indefinite. The claim has further been treated below as reading "issuing...digital certificates that are distributed..."

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Claim 14 is also rejected as being dependent upon a rejected base claim.

6. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites the limitation "a platform type indicating a type the platform". The incorrect use of grammar renders the claim indefinite. The claim has been further treated below as reading "a platform type indicating the type of platform in use by the client".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6, 10, 13-21, 23, 26, 29, 45, 46, 48, 49, 51, 52, 55, 56, 59, 60, 61, 64, 65, 68 and 72-74 are rejected under 35

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U.S.C. 102(e) as being anticipated by Christiano (U.S. Pat. No. 5,671,412).

Claim 1

Christiano teaches a method and system (fig. 1; col.6, li.1-31) for software license management and distribution substantially as claimed (See Abstract) comprising:

"creating a license pack..." Christiano teaches generating a license pack containing one or more software licenses (fig. 2a, ref.19; col.8, li.5-22);

"signing the license pack..." Christiano teaches using a digital signature to sign the license pack ("package certificate"; fig.2b, ref.18; col.8, li.57-63);

"issuing the license pack to a license server" (fig.2a, ref.16; col.8, li.30-45);

"verifying, at the license server..." Christiano teaches verifying the presence of the digital signature on the license pack (fig.9, ref.163; col.19, li.17-21);

"distributing the software..." Christiano teaches distributing the software licenses to corresponding clients (fig.2a, ref.12; col.4, li.12-14).

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Claim 2

Christiano further teaches the license pack containing a predefined number of software licenses (col.8, li.47-56) (See also fig.2a, ref.19).

Claim 3

Christiano further teaches creating a license pack ID ("key field"; col.9, li.35-36) at the license generator and evaluating the license pack ID at the license server (col.11, li.24-30).

Claim 4

Christiano teaches encrypting the license pack at the license generator and decrypting the license pack at the license server (col.14, li.19-35).

Claim 5

Christiano teaches creating license packs tailored to the particular operating platform in use by a client (col.23, li.66 to col.24, li.15) (See also col.24, li.49-57; col.21, li.38-40; col.16, li.52 to col.17, li.15).

Claim 6

Christiano further teaches determining the authenticity of a client prior to distributing the software license (col.6, li.50-57) (See also fig.10; col.21, li.2-7 & 51-65).

Claim 10

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Christiano further teaches granting additional licenses for a license pack having the same license pack ID ("components each with a unique license multiplier"; fig.2b; col.9, li.1-28).

Claims 13 and 14

Christiano teaches a method and medium (col.6, li.21-31) for electronically issuing software licenses as digital certificates (fig.2b; col.8, li.57-59) that can be distributed in one-to-one correlation with individual clients ("node-locked policy"; col.6, li.60 to col.7, li.1). Christiano further teaches the use of a package ID ("key field"; col.9, li.35-36) to allow tracing of a issued license.

Claims 15 and 20

Christiano further teaches a method, a medium (col.6, li.21-31) and an apparatus (col.6, li.19-21) for receiving a request for a license from a server (col.18, li.62 to col.19, li.15) (discussing requesting a specific license record from the license database). Christiano further teaches associating a license pack ID with a particular license server (col.10, li.7-17). The additional limitations found in these claims have been treated above in claims 1 and 3.

Claim 16

See Claim 2 above.

Claim 17

See Claim 5 above.

Claim 18

Christiano further teaches a license pack (fig.2b) including an expiration date (col.9, li.45-50) and a product ID ("component identifier" col.9, li.9-12). The additional limitations found in these claims have been treated above in claims 2 and 5.

Claim 19

See Claim 4 above.

Claims 21 and 29

Christiano teaches a method, a medium (col.6, li.21-31) and an apparatus (col.6, li.19-21) for software license management and distribution comprising:

"receiving a request..." Christiano teaches receiving a request from a client (fig.2a; col.10, li.25-31);

"determining an authenticity of the particular client" (col.6, li.50-57);

"selecting a software license..." Christiano teaches determining an appropriate software license, having an associated license ID ("license record key"; col.14, li.19-23), for a client (col.18, li.62 to col.19, li.36);

"associating the license ID with the particular client" ("user list"; col.19, li.50-53);

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"granting the software license to the particular client"

(col.4, li.12-19).

Claim 23

Christiano teaches granting a software license with information stored in table fields ("license record"; col.15, li.10-15), the information comprising an expiration date, license ID ("key"), product id ("name of the suite"), and version information, (col.15, li.40-57). Christiano further teaches the software license comprising an indication of the platform type in use by the client system (col.21, li.29-40; col.19, li.34-36) (discussing a resource capacity identifier as an indicator of a client platform).

Christiano further teaches a licensing method comprising a metering check to determine the time left on an active license (col.20, li.43-50). It is inherent that such a check must necessarily involve a comparison between an issue date of the license stored within a field and the expiration date of the license, also stored within a field.

Additionally, it is also inherent that the generation of a file on a client system (i.e. the issuance of a software license as taught by Christiano above) generates a directory listing including the creation date of the file.

Claim 26

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See Claim 5 above.

Claim 45

See Claim 1 above.

Claim 46

See Claim 3 above.

Claim 48

See Claim 2 above.

Claim 49

See Claim 5 above.

Claim 51 and 52

See Claim 21 above.

Claim 55

See Claim 15 above.

Claim 56

See Claim 18 above.

Claim 59

See Claim 1 above.

Claim 60

See Claim 21 above.

Claim 61

See Claim 26 above.

Claim 64

See Claim 23 above.

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Claim 65

Christiano further teaches a license pack table to store information pertaining to the license pack ("license database"; col.8, li.30-45).

Claim 68

See Claim 60 above.

Claim 72

Christiano teaches a data structure comprising:

"a license pack table..." Christiano teaches a table for storing information on individual license packs, each containing one or more software license, indexed by license pack ID ("key"; col.9, li.35-36; fig.2b, ref.20);

"a client assignment table..." Christiano teaches a table for storing information pertaining to software licenses assigned to clients ("user list" maintained in a license record; col.19, li.50-53). The license record is further taught to contain the license pack ID ("key") for cross-indexing purposes (col.15, li.30-32).

Claim 73

Christiano further teaches granting a software license with information stored in table fields ("license record" stored within an "internal database"; col.15, li.10-15) (See also col.15, li.58-61). The information comprising fields for

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storing a license ID ("key"), quantity field ("number of suite licenses available"), expiration date, product id ("name of the suite"). Christiano further teaches the software license comprising a field storing an indication of the platform type in use by the client system (col.21, li.29-40; col.19, li.34-36) (discussing a resource capacity identifier as an indicator of a client platform).

Claim 74

Christiano further teaches the license pack table containing a number representative of how many licenses have been assigned to clients (col.19, li.50-53).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 54, 69, 71, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christiano.

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Claim 54

Christiano teaches distributing software licenses to clients connected over a network (col.6, li.7-21). At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate intermediate web servers into the network of Christiano to allow for the distribution software licenses over the Internet. The Examiner takes Official Notice that the Internet was well-known at the time of the invention. As such, the modification would have been obvious because one of ordinary skill would have been motivated to allow remote users to request and receive software licenses over the Internet using the method of Christiano in order to increase the functionality and accessibility of the system to remote users.

Claims 69 and 71

It would have been obvious to one of ordinary skill in the art at the time of the invention that the requesting client system would satisfy the limitations, as claimed. (See treatment of Claim 21, above).

Specifically, the Examiner takes Official Notice that the client computer, as taught by Christiano, would contain memory functional to store software, a mechanism to send requests, and an event handler operable to store received data into memory.

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Each of these elements, as claimed, were well-known components in a computing system operating in a client-server environment.

Claim 76

Christiano teaches the majority of limitations as claimed (See treatment of Claim 73, above). The additional limitation is a data structure comprising a begin serial number to hold a beginning serial number of the software licenses contained in the license pack. Christiano teaches a data structure comprising a field to capture useful information associated with a software license not elsewhere captured (fig.2b, ref.22; col.9, li.45-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention that a beginning serial number of a software license sequence would have been useful information to capture in order to 1) document the sequential issuance of software licenses and to 2) capture information to allow an alternative means of data mining and querying through known database methodologies.

11. Claims 24, 25, 27, 47, 53, 57, 75, 77 and 78 rejected under 35 U.S.C. 103(a) as being unpatentable over Christiano as applied to claim 21 above, and further in view of Cohen (U.S. Pat. No. 6,233,567).

Claims 24 and 25

Christiano teaches a method for determining the authenticity of a client using a unique identifier (col.6, li.50-57) (See also col.1, li.27-30). However, Christiano does not expressly teaches the limitations as claimed. In the analogous art of software licensing, Cohen teaches receiving and storing in a field a client software ID ("machine unique identifier") from a client; and evaluating the client software ID by comparing it to a stored client image ("registration key") to determine if it is authentic (col.4, li.1-7) (See also col.4, li.57-62; col.5, li.42 to col.6, li.37).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Cohen into the method of Christiano. The modification would have been obvious because one of ordinary skill would have been motivated to verify the unique identity of client systems prior to the issuance of software licenses in order to prevent illegal use and monitor the systems using the software as taught in Cohen and suggested by Christiano (col.19, li.50-53) (discussing the use of a user list to document and track client requesting licensing rights).

Claim 27

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Christiano teaches a method for additional security in the distribution of software licenses utilizing encryption and decryption (col.10, li.48-52). However, Christiano does not expressly teach the limitation as claimed. In the analogous art of software licensing, Cohen teaches encrypting a software license using a public key of a particular client (fig.1, ref.92; col.5, li.57-67).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Cohen into the method of Christiano. The modification would have been obvious because one of ordinary skill in the software art would have been motivated to further ensure the secure transfer of software licenses over a network by using known encryption techniques to prevent illegal software use as taught in both Cohen and Christiano (col.19, li.50-53).

Claim 47

See treatment of Claim 4 in view of Claim 27, above.

Claim 53

See Claim 27 above.

Claim 57

See treatment of Claim 15 in view of Claim 27, above.

Claim 75

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See treatment of Claim 72 above. Christiano teaches a data structure comprising information stored in table fields ("license record"; col.15, li.10-15), the information comprising a license pack ID ("package name"; fig.2b, ref.24) and license ID ("key"). Christiano further teaches a metering check to determine the time left on an active license (col.20, li.43-50).

Christiano further teaches a licensing method comprising a metering check to determine the time left on an active license (col.20, li.43-50). It is inherent that such a check must necessarily involve a comparison between an issue date of the license stored within a field and the expiration date of the license, also stored within a field.

Additionally, it is also inherent that the generation of a file on a client system (i.e. the issuance of a software license as taught by Christiano above) generates a directory listing including the creation date of the file.

Claim 77

See treatment of Claims 23, 73 and 75, above. Christiano teaches a data structure comprising the information as claimed.

Claim 78

Christiano further teaches a data structure comprising a description field to hold a written description of the software license ("component name"; fig.2b, ref.34; col.9, li.9-12).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Gubiotti whose telephone number is (703) 305-8285. The examiner can normally be reached on M-F, 8-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703) 305-9662. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MPG
June 13, 2003

Kakali Chaki
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